

REMARKS

The Specification has been amended to use the proper format for the registered trademark ROUNDUP and to provide clarity. Applicant has amended paragraph [0120] of the Specification to correct a typographical error. The Specification has been amended to include the ATCC Accession number. A copy of the ATCC deposit receipt is attached. Applicant has amended claims 1, 3-6, 10, 12, 14-15, 18, and 20-29. Claim 30 has been added. These changes have been made to place the claims in better form for examination and to further obviate the 35 U.S.C. §§102(b), 103(a) and 112 rejections as set forth in the Office Action dated August 10, 2006. It is believed that none of these amendments constitute new matter. It is submitted that these amendments obviate the rejections. Withdrawal of these rejections is respectfully requested.

The Examiner has objected to claims 1, 6, 22, 23, and 28 for containing a blank line where the ATCC accession number should be. Applicant has added the ATCC accession number to claims 1, 6, 22, 23 and 28. Withdrawal of this objection is respectfully requested.

The Examiner has objected to claim 28, line 2. Applicant has amended claim 28 as suggested by the Examiner. Withdrawal of this rejection is respectfully requested.

The Examiner has rejected claims 1-29 under U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has rejected claims 1, 6, 22, 23, 24, 28, and 29 for being indefinite for the recitation "SG5322NRR". Applicant has added the ATCC Accession Number to claims 1, 6, 22, 23, and 28. Withdrawal of this rejection is respectfully requested.

The Examiner has rejected claims 1-29 under §112, first paragraph, as failing to comply with the enablement requirement. Applicant has amended claims 1, 6, 22, 23, and 28 to include the ATCC Accession Number. Additionally, the undersigned avers that:

- a) access to the invention will be afforded to the Commissioner during the pendency of the application;

- b) all restrictions upon availability to the public will be irrevocably removed upon the granting of a patent;
- c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the enforceable life of the patent, whichever is longer;
- d) a test of the viability of the biological material at the time of deposit was performed; and
- e) the deposit will be replaced if it should ever become inviable or when requested by ATCC.

Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner has rejected claims 23-29 under 35 U.S.C. §112, first paragraph, because the specification does not reasonably provide enablement for the claimed methods when fewer than a fourth backcross progeny plants are produced. Applicant has amended claims 23 and 28. Withdrawal of this rejection is respectfully requested.

The Examiner has rejected claims 1-9 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Shannon (U.S. Patent No. 6,013,865, issued January 11, 2000). Applicant has submitted with this response, a response to a Request for Information under 37 C.F.R. §1.105 in which additional information concerning the parents of soybean cultivar SG5322NRR and the methods and steps used to produce soybean cultivar SG5322NRR are included as a Trade Secret. Soybean cultivar SG5322NRR has different parents than soybean cultivar 93-13946 from U.S. Patent No. 6,013,865. Soybean cultivar 93-13946 was developed from the cross of A5403 X DP3589 derived lines. Additionally, Applicant points out that there are significant differences in seed coat luster (soybean cultivar SG5322NRR has a dull seed coat while soybean cultivar 93-13946 has a shiny seed coat), seed size (soybean cultivar SG5322NRR has a seed size of 12 grams per 100 seeds while soybean cultivar 93-13946 has a seed size of 15 grams per 100 seeds), and disease resistance to Phytophthora (soybean cultivar SG5322NRR is resistant to Phytophthora Root Rot Race 2 and susceptible to Race 4 while soybean cultivar 93-13946 is field tolerant to Phytophthora

Root Rot Race 1) and Soybean Cyst Nematode (soybean cultivar SG5322NRR is resistant to Soybean Cyst Nematode Race 14 while soybean cultivar 93-13946 is only moderately resistant). Therefore, soybean cultivar SG5322NRR of the instant invention is nonobvious over soybean cultivar 93-13946 of U.S. Patent No. 6,013,865 and therefore is patentable over U.S. Patent No. 6,013,865. Withdrawal of this rejection is respectfully requested.

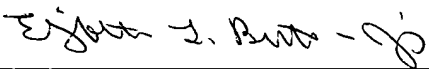
The Examiner has rejected claims 1-29 under 35 U.S.C. §103(a) as being unpatentable over Shannon (U.S. Patent No. 6,013,865, issued January 11, 2000) in combination with Schultze (U.S. Patent No. 6,838,597, issued January 4, 2005). Applicant has submitted with this response, a response to a Request for Information under 37 C.F.R. §1.105 in which additional information concerning the parents of soybean cultivar SG5322NRR and the methods and steps used to produce soybean cultivar SG5322NRR are included as a Trade Secret. Applicant points out that there are significant differences in seed coat luster (soybean cultivar SG5322NRR has a dull seed coat while soybean cultivar 93-13946 has a shiny seed coat), seed size (soybean cultivar SG5322NRR has a seed size of 12 grams per 100 seeds while soybean cultivar 93-13946 has a seed size of 15 grams per 100 seeds), and disease resistance to Phytophthora (soybean cultivar SG5322NRR is resistant to Phytophthora Root Rot Race 2 and susceptible to Race 4 while soybean cultivar 93-13946 is field tolerant to Phytophthora Root Rot Race 1) and Soybean Cyst Nematode (soybean cultivar SG5322NRR is resistant to Soybean Cyst Nematode Race 14 while soybean cultivar 93-13946 is not resistant). Therefore, soybean cultivar SG5322NRR of the instant invention is nonobvious over soybean cultivar 93-13946 of U.S. Patent No. 6,013,865 and therefore is patentable over U.S. Patent No. 6,013,865 in combination with U.S. Patent No. 6,838,597. Withdrawal of this rejection is respectfully requested.

Applicant has submitted in a separate document the Request for Information under 37 C.F.R §1.105, in which the information is a Trade Secret.

In view of the above amendments and remarks, it is submitted that the claims satisfy the provisions of 35 U.S.C. §§112, 102(b), and 103(a). Reconsideration of this application and an early notice of allowance are respectfully requested.

Application No. 10/764,370
Amendment dated November 9, 2006
Office Action dated August 10, 2006

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SIGNATURE OF APPLICANT, ATTORNEY OR AGENT REQUIRED					
NAME AND REG. NUMBER	Elizabeth L. Bennett-Jarvis, Reg. No. 53,982				
SIGNATURE			DATE	November 9, 2006	
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Country	U.S.A.	Telephone	303-799-6444	Fax	303-799-6898

ATCC

10801 University Blvd • Manassas, VA 20110-2209 • Telephone: 703-365-2700 • FAX: 703-365-2745

BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

INTERNATIONAL FORM

RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT ISSUED PURSUANT TO RULE 7.3 AND VIABILITY STATEMENT ISSUED PURSUANT TO RULE 10.2

To: (Name and Address of Depositor or Attorney)

Jondle and Associates PC
ATTN: Kenyon L. Schuett
858 Happy Canyon Rd. Suite 230
Castle Rock, CO 80108

Deposited on Behalf of: Soygenetics, LLC

Identification Reference by Depositor:

Soybean Glycine max)L.): SG5322NRR

Patent Deposit Designation

PTA-7870

The deposit was accompanied by: ☒ a scientific description ☐ a proposed taxonomic description indicated above.

The deposit was received September 13, 2006 by this International Depository Authority and has been accepted.

AT YOUR REQUEST: ☒ We will inform you of requests for the strain for 30 years.

The strain will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive, or if a U.S. Patent is issued citing the strain, and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strain.

If the culture should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace it with living culture of the same.

The strain will be maintained for a period of at least 30 years from date of deposit, or five years after the most recent request for a sample, whichever is longer. The United States and many other countries are signatory to the Budapest Treaty.

The viability of the culture cited above was tested October 16, 2006 . On that date, the culture was viable.

International Depository Authority: American Type Culture Collection, Manassas, VA 20110-2209 USA.

Signature of person having authority to represent ATCC:


Dee Bishop, ATCC Patent Depository

Date: October 19, 2006

Ref: Docket or Case # 1379-012